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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Confirmation No.: 4612
)	
Achim MELCHING, et al.)	Group Art Unit: 3651
)	
Application No.: 10/766,901)	Examiner: Khoi H. Tran
)	
Filed: January 30, 2004)	

For: LIGHT EMITTING DIODE AND METHOD FOR MANUFACTURING THE SAME

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

By Official Action dated August 9, 2005, restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-9, drawn to a climatic cabinet and a transporting device, classified in class 700, subclass 231, or class 221, subclass 150R.
- II. Claims 10-12, drawn to a method for examining a specimen in a climatic chamber, classified in class 700, subclass 228, or class 422.

In response, Applicant hereby elects group I for examination in this case, with traverse.

The Examiner is respectfully reminded that there are two criteria for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be distinct as claimed. Second, examination of the claimed distinct inventions must present a serious burden on the Examiner. *MPEP* § 803. A process and apparatus for its practice can be

shown to be distinct inventions if the Examiner can demonstrate either that the process as claimed can be practiced by another materially different apparatus or by hand, or that the apparatus as claimed can be used to practice another and materially different process. *MPEP* § 806.05(e).

An Examiner is seriously burdened by having to examine all of the claims if (1) each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search; (2) even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors; or (3) a different field of search is required. *MPEP* § 808.02.

In the Official Action, the Examiner states that the invention described in claims 1-9 is distinct from the invention described in claim 10-12 because the method of examining the specimen could be practiced by another materially different climatic chamber and/or another materially different monitoring device. Furthermore, the Examiner implicitly argues that the examination of all of the claims would be seriously burdensome because claims 1-9 and claims 10-12 belong in separate classes and/or subclasses.

The Applicant respectfully disagrees with the Examiner's arguments, and submits that Examiner has failed to meet both parts of the test that must be met before a restriction can be required. First, the Examiner has not demonstrated sufficiently either that the process as claimed can be practiced by another materially different apparatus or by hand, or that the apparatus as claimed can be used to practice another and materially different process.

Second, the Examiner is incorrect in his assertion that claims 1-9 and claims 10-12 require different classifications. Claims 1-9 are directed toward a climatic cabinet with specimen storage places, a transporting device, and a monitoring device. Claims 10-12 are directed to a method for examination of a specimen in a climatic cabinet with specimen storage places, a transporting device, and a monitoring device. All of these claims can be classified in class 198,

subclass 348: Conveyor Arrangement for Selecting Among Plural Sources or Destinations.

Therefore, the Examiner has not demonstrated that he is seriously burdened by having to examine all of the claims presented.

Thus, while the inventions being separately patentable, they are related to the same art and the Examiner should not be unduly burdened in doing search and examination. Applicants therefore respectfully request that the restriction requirement be removed and all the pending claims be rejoined.

Respectfully submitted,

Baker & Hostetler LLP

A handwritten signature in black ink, appearing to read 'D. Cawley', is written over a horizontal line.

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